

### R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

### SUPPORT FOR AMENDMENTS TO THE CLAIMS

Support for the amendments to the claims can be found in the drawings as originally filed, for example, on FIGS. 1-4 and in the specification as originally filed, for example, on page 7, line 18 through page 8, line 7 and on page 9, line 16 through page 11, line 4. As such, no new matter has been introduced.

### CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 1-10 and 13-18 under 35 U.S.C. §102(a) as being anticipated by OTG Supplement to the USB 2.0 Specification, Revision 1.0 (hereinafter the OTG Spec) is respectfully traversed with respect to claims 1-10 and 13 and has been obviated by appropriate amendment with respect to claims 17-18. As such, the rejection should be withdrawn.

The rejection of claims 19 and 20 under 35 U.S.C. §102(a) as being anticipated by OTG Supplement to the USB Specification 1.0 (hereinafter OTG Spec) has been obviated by appropriate amendment and should be withdrawn.

The Federal Circuit has stated that "[a]nticipation requires the presence in a single prior art reference disclosure of **each and every element** of the claimed invention, **arranged as in the**

**claim.**"<sup>1</sup> The Federal circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."<sup>2</sup>

With respect to claims 1-10 and 13, the Office Action fails to present any evidence or convincing line of reasoning to support a conclusion that, as viewed by one of ordinary skill in the art, there is no difference between the presently claimed first, second and third CIRCUITS and the OTG Spec. As such, the Office Action fails to factually establish a *prima facie* case of anticipation and the rejections should be withdrawn.

Specifically, the Office Action merely cites sections of the OTG spec as providing the presently claimed structures (circuits) as if preparing a shopping list. However, assuming, *arguendo*, one skilled in the art would recognize the cited passages of the OTG Spec as being the same as the presently claimed first circuit, second circuit and third circuit (as suggested by the Office Action on page 2, section 1 and for which Applicants' representative does not necessarily agree), the Office Action does not appear to even attempt to provide evidence or a convincing line of reasoning why one of ordinary skill in the art would consider

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<sup>1</sup> *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added).

<sup>2</sup> *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

the OTG Spec as disclosing or suggesting that the elements must necessarily be arranged as presently claimed. As such, the Office Action fails to factually establish a *prima facie* case of anticipation and the rejections should be withdrawn.

Furthermore, assuming *arguendo*, Section 6.3 of the OTG Spec could be considered similar to the presently claimed third circuit (as suggested by the Office Action on page 2, section 1 and for which Applicants' representative does not necessarily agree), Section 6.3 of the OTG Spec does not disclose or suggest **a third circuit** configured to (i) **control said first and said second circuits** and (ii) transfer information between said first and said second circuits, as presently claimed. Specifically, Section 6.3 of the OTG Spec is directed to an overview of a Host Negotiation Protocol (HNP). Section 6.3 reads:

HNP is used to transfer control of a connection from the default Host (A-device) to the default Peripheral (B-device). This is accomplished by having the A-device condition the B-device to be able to take control of the bus, and then having the A-device present an opportunity for the B-device to take control (Section 6.3 of the OTG Spec, *emphasis added*).

One of ordinary skill in the art would not understand Section 6.3 of the OTG Spec as disclosing or suggesting **a THIRD circuit configured to (i) control said first and said second circuits** and (ii) transfer information between said first and said second circuits, as presently claimed. Therefore, the Office Action fails to meet the Office's burden to factually establish a *prima facie* case of anticipation by presenting a single prior art reference

disclosing or suggesting each and every element of the claimed invention, arranged as in the claims. As such, the presently claimed invention is fully patentable over the cited reference and the rejections should be withdrawn.

Furthermore, Section 1.3 of the OTG Spec states that the intended audience of the specification is developers of PC peripherals and portable consumer electronic devices. Since the OTG Spec is targeted to DEVELOPERS, one of ordinary skill in the art would recognize the OTG Spec as a guideline to be taken into account when designing CIRCUITS, not a specification of a circuit. As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

With respect to claims 17 and 18, claim 17 has been amended to recite the steps of (A) configuring a host interface to couple to a legacy USB peripheral device, (B) coupling an OTG host/peripheral interface to the host interface and (C) generating one or more control signals configured (i) to control operation of the host interface and the OTG host/peripheral interface and (ii) to communicate information between the host and the OTG host/peripheral interfaces, wherein the legacy USB peripheral device appears to be a USB on-the-go (OTG) dual role device (DRD). The OTG Spec does not appear to disclose or suggest each and every element of claim 17, arranged as in claim 17. As such, claim 17 is fully patentable over the cited reference and the rejection should be withdrawn.

Claims 2-10, 13-15 and 18-20 depend, directly or indirectly from either claim 1 or claim 17 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited reference and the rejections should be withdrawn.

**CLAIM REJECTION UNDER 35 U.S.C. §103**

The rejection of claims 11, 12 and 21 under 35 U.S.C. §103 as being unpatentable over OTG Spec in view of Official Notice taken is respectfully traversed with respect to claims 11 and 12 and, with respect to claim 21, has been obviated by appropriate amendment. As such, the rejection should be withdrawn.

Claims 11 and 12 depend indirectly from claim 1 which is believed to be allowable. Claim 21 includes all the limitations of claim 17, incorporated by reference, which is believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

New claims 22 and 23 depend from claim 1 which is believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references.

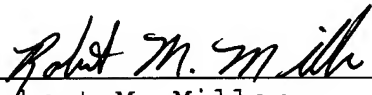
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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